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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/573,330

03/24/2006

Janine T. Bryan

21500P

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210 7590 12/19/2006  
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EXAMINER

SALIMI, ALI REZA

ART UNIT

PAPER NUMBER

1648

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

12/19/2006

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/573,330	<b>Applicant(s)</b> BRYAN ET AL.	
	<b>Examiner</b> A R. Salimi	<b>Art Unit</b> 1648	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 19-23 is/are pending in the application.
- 4a) Of the above claim(s) 9-17 and 19-23 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/24/06</u> . | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

Claims 1-17, 19-23 are pending.

Raw Sequence Listing have been entered.

Submitted Information Disclosure Statement (I.D.S) is noted.

### ***Election/Restriction***

Applicant's election with traverse of Group I in Paper filed 11/20/2006 is acknowledged. The traversal is on the ground(s) that the subject matters of Groups I, and II should be examined together. Upon reconsideration, Applicants' argument is persuasive regarding rejoinder of groups I-II. Hence, claims 1-8 have been rejoined.

However, regarding the Groups III-IV (9-17, 19-23) the restriction is still deemed valid under PCT Rule 13.2. This portion of the requirement is still deemed proper and is therefore made FINAL.

**Applicants are reminded to cancel the claims to the non-elected claims. Claims 1-8 are considered.**

### ***Oath/Declaration***

The data provided by the Applicants in the Oath/Declaration is not consistent. The provisional application 60/506,812 was filed on 09/29/2003, and not on 09/23/2003. Appropriate correction is requested.

### ***Subject Matter Allowable over Prior art***

Claims 1-8 are deemed free of prior art, given failure of the prior art to teach or reasonably suggest the codon optimized nucleotides of HPV-45 L1 as defined SEQ ID NO: 1.

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The closest prior art identified is by Sette et al (WO 01/41799). Sette et al taught the polypeptide of the codon optimized HPV-45 L1 as defined under the accession number CAB44705 i.e. SEQ ID NO: 2 (see page 25). Sette et al did not, however, disclose the nucleic acid of codon modified HPV-45 L1 of SEQ ID NO: 1, and there is no teaching of expression of SEQ ID NO: 1 in yeast cell in general, or *Saccharomyces cerevisiae* in particular. Secondly, teaching of Robinson Robin (US PUB NO.: US 2004/0121465 A1) broadly teaches codon-optimized polynucleotide including HPV-45, the reference, however, does not disclose SEQ ID NO: 1. To form this determination Office has relied on the holdings of: In re Deuel, 51 F.3d 1552, 1558-59, 34 USPQ2d 1210, 1215 (Fed. Cir. 1995); and In re Bell, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir.1993).

Claims 1-8 are allowed.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. R. Salimi whose telephone number is (571) 272-0909. The examiner can normally be reached on Monday-Friday from 9:00 Am to 6:00 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The Official fax number is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A. R. Salimi

12/12/2006

✓  
ALI R. SALIMI  
PRIMARY EXAMINER